

REMARKS

Reconsideration of the rejection of the claims in this application for the reasons set forth in the Office Action mailed March 19, 2002; Paper Number 9, is respectfully requested in view of the foregoing amendment of the claims and the remarks that follow.

By the foregoing amendment, Claims 1, 10, 16, 23 and 29 have been amended to specify that the resultant composition contains 0% to 10% by weight of water based upon the paragraph set forth in the specification beginning at page 12, line 31 to page 13, line 8. Further, Claim 6 has been amended to correct an inadvertent error and provide proper antecedent basis for the water-soluble surfactant. The foregoing amendments are deemed to proper and in compliance with 35 USC 132.

Because Paper No. 9 required restriction under 35 USC 121 either to Claims 1 – 34 drawn to compositions or Claims 35 and 37 drawn to methods of using the claimed compositions, Applicant elects with traverse to prosecute Claims 1 – 34 drawn to compositions. Therefore, the foregoing amendment cancels Claims 35 and 37. Applicant's reasons in support of the traverse are set forth more specifically in the discussion that follows.

More particularly, the Examiner's basis for restriction is that the composition invention and the process of use invention "can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product....In the instant case the product as claimed can be used in materially different process....the compositions can be used for cleaning...dishes." Firstly, the process for using the product as claimed can not be practiced with a different product because the claimed method of use is restricted to the method of using the composition of Claim 1 and is dependent

upon Claim 1. Further, as the Examiner properly notes, the claimed composition in use deposits a film of emollient material on the washed substrate and, therefore, the composition would be unsuitable for use in washing dishes as asserted by the Examiner because no one would want to have a film of emollient on the dishes after the washing process. The Manual of Patent Examining Procedure (MPEP) section 806.05(h) states that the Examiner must state a reason in support of the requirement. Because the Examiner's reasons in support of his requirement for restriction herein are not valid, said requirement for restriction should be withdrawn by the Examiner.

For the record, the requirement for restriction under 35 USC 121 is discretionary with the Commissioner. Where, as here, the composition and the method of use are related and further the composition invention and the method of use invention are classified in the same class and subclass, i.e., Class 424, subclass 401, MPEP 808.02 implies that there is no valid reason for restriction. This is an additional reason why the requirement for restriction should be withdrawn by the Examiner.

Because the Examiner herein has not stated any valid reason in support of his requirement for restriction and both inventions can be searched in the same Class and Subclass, it is requested that the requirement for restriction herein be withdrawn. However, since composition and method of use of the composition can be shown to be distinct, Applicant elects with traverse to prosecute composition Claims 1 – 34 in this application.

Additionally, Paper No. 9 states "Claims 1-35 and 37 are generic to a plurality of disclosed distinct species....Applicant is required under 35 USC 121 to elect a single disclosed species of A, B, C and D...." The requirement to elect a patentably distinct species does not comply with 35 USC 121 because claims 1 – 7 and 8 – 34 are related as claimed and the examiner has not pointed out any species that recites limitations that are not present in a second species as required under

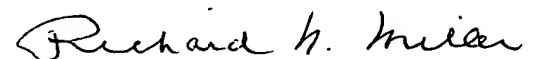
MPEP 806.04f and 808.01 (paragraph 1). Further, the Examiner has not pointed out any covered species that is unpatentable as required in MPEP 808.01 (paragraph 4) or stated that a search on merits would be burdensome as required MPEP 808.01a (paragraph 6). Finally, MPEP 808.02 is deemed to be dispositive of the requirement for election of single species stating as follows:

“Where, as disclosed in the application, the several inventions as claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC 121 is never proper.” Accordingly, the requirement to elect a single species of A, B, C and D should be withdrawn for being not in accord with 35 USC 121. Again, for the purposes of a complete response to Paper No. 9 and to facilitate the prosecution of this application, Applicant elects with traverse to prosecute Claims 38 and 39 that were added in the foregoing amendment of the claims herein.

In conclusion, Applicant has invented a new and useful composition and method of using that composition. The subject composition and method of its use as claimed are related. Further, the composition Claims 1 – 34 have not shown to cover multiple inventions that would require divisional applications. Thus, the requirement for restriction set forth in Paper No. 9 is not in accord with 35 USC 121 and should be withdrawn by the Examiner and the examination on the merits should proceed. Applicant hereby specifically requests that foregoing action be taken.

If the Examiner has any questions regarding this response, he is urged to make a collect telephone to the undersigned attorney at 973-338-4660.

Respectfully submitted,



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